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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,939	01/30/2004	Thomas Robert Gold	672P001	7176

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EXAMINER

CHIU, RALEIGH W

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/768,939	Applicant(s) GOLD, THOMAS ROBERT	
	Examiner Raleigh Chiu	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The recited steps are still not considered to fall within the classic definition of a process and, accordingly, is not a "process" within the meaning as used in 35 USC 101. The classic definition of a process is "an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing". See *Cochrane v. Deener*, 95 U.S. 780. Moreover, "transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines". See *Gottschalk v. Benson*, 175 USPQ 673.

In the instant case, the process claims do not include a particular machine and nothing is transformed or reduced to a different state or thing; all that is claimed is a process that is implemented by the movements of a human being without the aid of a machine. While the golf club and golf ball set forth in

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the claim are manipulated and moved in space, both elements remain precisely what they were before the process was performed. That is to say, they are implements used by an intervening human being and not machines used in or for carrying out the method. The result is that a human being moves, rather than transforms, subject matter from one point in space to another with the aid of implements. As a consequence, all that is left is a manipulation of subject matter, a procedure or a common dictionary-definition of a process, but not a process within the meaning of 35 USC 101.

Therefore, because the claimed method does not include a particular machine and because there is no transformation of subject matter so as to reduce it to a different state or thing, the claimed method is not properly characterized as a process within the meaning of the patent statutes and is thus ineligible to receive a patent.

Under recent Federal Circuit guidance in the context of computer-related inventions employing mathematical algorithms, the "useful, concrete and tangible result" test has emerged. See *In re Allapat*, 31 USPQ2d 1545; *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596; *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447.

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While the instant case is non-machine implemented and does not relate to a mathematical algorithm, to the extent that the "useful, concrete and tangible result" test applies outside the context of computer algorithms, the claimed method of swinging a golf club is not sufficiently concrete because the claim requires such a degree of subjective human judgment that a reasonably consistent result cannot be predicted or assured.

Therefore, because the claimed method is merely limiting the natural motion of a person and does not serve to produce a result that can be fairly characterized as useful, tangible and concrete, it does not meet the modern test for patent-eligible subject matter and is therefore not eligible for patent protection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Because claims 1-34 are considered non-statutory, a person having ordinary skill in the art would not be able to perform the claimed invention as intended without undue experimentation.

Claim Rejections - 35 USC §§ 102 and 103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 2, 4 and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Collins (USPN 5,785,608) as set forth in the previous Office action.

Regarding claims 1, 10 and 12, Figure 8 of Collins shows the club shaft 74 positioned in the armpit area of a player with the target side hand and other hand also gripping the shaft.

Regarding claim 2, Figure 8 further shows the shaft exiting the palm between the thumb and forefinger of the target side hand.

Regarding claim 4, Figure 8 further shows the shaft exiting the palm between the thumb and forefinger of the other hand.

Regarding claim 7, Figure 8 shows the two hands to be overlapping.

Regarding claims 8 and 9, Figure 8 shows target arm 78 to be substantially extended and substantially parallel to the club shaft.

Regarding claim 11, the Collins club can inherently be used for chipping.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Shioda (USPAPN 2004/0166956) for the reasons set forth in the previous Office action.

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Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a grip such that the club passes between the index finger and the ring finger of the target hand in view of Shioda who teaches that such a grip (Shioda, Figure 14) provides additional stability to a golfer during his swing.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Carlucci (USPN 5,913,738) for the reasons set forth in the previous Office action.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a fist of the other hand in view of Carlucci who teaches that such a grip prevents the player from "breaking" his wrists, thereby avoiding a problem contributing to inaccurate putts.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of (Miller (USPN 5,616,089) and applicant's admission of the prior art as set forth in the previous Office action.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club by grasping the forearm of one hand with the target hand in view of Miller who shows that such a grip allows a player to use his non-dominant hand to stabilize the club. However, since applicant

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admits that a widely used variation of the putting grip is the "cross handed" grip (specification, page 4), it would have been obvious to one of ordinary skill in the art to provide a variant of the Miller stabilizing grip by reversing the position of the hands, thereby reducing the possibility of variation and error by allowing the target side hand to control the stroke.

11. Claims 13, 14, 16, 19-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins for the reasons set forth in the previous Office action.

Regarding claims 13, 14, 16 and 19-22, Collins describes Figure 8 at column 5, lines 34-50. Although Collins does not explicitly describe the shaft remaining in the armpit area during the putting stroke, it would have been obvious to one of ordinary skill in the art to do so for a consistent, continuous stroke.

Regarding claim 23, the Collins club can inherently be used for chipping.

Regarding claims 25, 27 and 28, a typical putting stroke is considered to meet the recited movements.

Regarding claims 26 and 29, as many putting strokes and techniques translate well to other short-game strokes such as chipping, it would have been obvious to one of ordinary skill in the art to extend the Collins teaching to chipping strokes as

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well; the chipping stroke is considered to meet the recited shoulder movements.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Shioda for the reasons set forth in the previous Office action.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a grip such that the club passes between the index finger and the ring finger of the target hand in view of Shioda who teaches that such a grip (Shioda, Figure 14) provides additional stability to a golfer during his swing.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Carlucci as applied above for the reasons set forth in the previous Office action.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a fist of the other hand in view of Carlucci who teaches that such a grip prevents the player from "breaking" his wrists, thereby avoiding a problem contributing to inaccurate putts.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins in view of Miller and applicant's admission of the prior art as set forth in the previous Office action.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club by grasping the forearm of one hand with the target hand in view of Miller who shows that such a grip allows a player to use his non-dominant hand to stabilize the club. However, since applicant admits that a widely used variation of the putting grip is the "cross handed" grip (specification, page 4), it would have been obvious to one of ordinary skill in the art to provide a variant of the Miller stabilizing grip by reversing the position of the hands, thereby reducing the possibility of variation and error by allowing the target side hand to control the stroke.

15. Claims 30, 32 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Shioda as set forth in the previous Office action.

Regarding claim 30, Figures 14-23 show the recited grips by the target side hand and the other hand.

Regarding claim 32, Figures 20-21 show the target side hand below the other hand.

Regarding claim 33, Figures 6-12 appear to show a putter.

16. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shioda for the reasons set forth in the previous Office action.

As Shioda discloses his grip does not create additional tension in the golfer's arm, thereby preventing extraneous motion, one of ordinary skill would realize that such a benefit would apply to all golf strokes, including chipping.

Response to Arguments

17. Applicant's arguments filed 06 September 2005 have been fully considered but they are not persuasive.

To the extent that the claims were not considered to be within the "technological arts" or "useful arts", such a rejection has been withdrawn. *Ex parte Lundgren*, Appeal No. 2003-2088.

However, the method claims are still not considered to transform the subject matter to a different state or thing to be a statutory process as well as fail to produce a useful, concrete and tangible result for the reasons set forth above.

Applicant argues that Collins requires the end of the putter positioned between the user's forward arm and ribs, and not the armpit or front of the shoulder as required by the instant claims. While Collin's Figure 8 shows a portion of grip 74 positioned between the user's forward arm and ribs, it is also noted that Figure 8 further shows the proximal end of the club (shown in phantom) adjacent to the user's armpit.

Although applicant also argues that the instant method is designed to maintain the torso out of the swing, the claims fail to recite such a limitation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Regarding Shioda, applicant that the critical element of claim 30 requires that the club enter the "target side hand at the top of the palm, traveling along the so-called life line" (emphasis included), especially as shown in Figure 5B. However, claim 30 makes no mention of a so-called life line. And, as similarly set forth above, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

The life line notwithstanding, Figure 14 of Shioda shows the target hand gripping the club in virtually the same manner as shown in applicant's Figure 5B. To the extent that the "top" of the palm can be defined as that portion opposite the fingers, Shioda shows such an arrangement in at least Figures 14, 15 and 20-23 and is considered to meet the limitations set forth in claims 30, 32 and 33. Further, in view of the fact that the claims fail to include any recitation with respect to the user's pinkie pad and wherein the remainder of the claim language does

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not otherwise limit the pinkie pad, applicant's arguments regarding such are considered moot.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

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A handwritten signature in black ink, appearing to read 'R. Chiu', with a large, stylized flourish extending from the end.

Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif
23 November 2005